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10/801,238	03/15/2004	David Lawrence	G08.147/U	2021

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EXAMINER	
RANKINS, WILLIAM E	

ART UNIT	PAPER NUMBER
3696	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/801,238	LAWRENCE, DAVID	
	Examiner	Art Unit	
	WILLIAM E. RANKINS	3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *2 and 13-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Claims 1 and 3-12 are pending in this application. Claim 1 has been amended and claims 3 and 12-19 have been cancelled.

Response to Argument

Response to Double Patenting Rejection

1. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Response to Claim Rejections - 35 USC § 103

2. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection provided below.

3. Applicant's arguments filed 01/14/2008 have been fully considered but they are not persuasive. In response to applicant's argument for claims 10 and 11 that Buist et al. (2002/0035534) and Maltzman (2002/0107779) are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if

not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the applicant's disclosure is directed toward pre-auction and auction processes for the fair sale of shares of securities. The primary reference, Maltzman is directed toward pre-auction and auction processes and the secondary reference is directed toward auction processes for the fair sale of securities. Both references are directed toward auction processes and are classified in 705/37 and are thus analogous art.

4. Applicant's arguments filed 01/14/2008 have been fully considered but they are not persuasive. In response to applicant's argument for claim 12 that Eckert et al. (2002/0069161) and Maltzman (2002/0107779) are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the applicant's disclosure is directed toward pre-auction and auction processes for the fair sale of shares of securities. The primary reference, Maltzman is directed toward pre-auction and auction processes and the secondary reference is directed toward auction processes (Para. 0144). Both references are directed toward auction processes and are thus analogous art.

Double Patenting

1. Claims 1-12 were rejected for double patenting in the previous office action. The applicant has pointed out that the statement of statutory basis was directed toward a statutory double patenting rejection under 35. U.S.C. 101 while the actual double patenting rejection was directed toward a provisional non-statutory obviousness-type double patenting rejection. The examiner asserts that the statement of statutory basis was intended to encompass a provisional non-statutory obviousness-type double patenting rejection. The statement of statutory basis follows below.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 3-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/730,224. Although the conflicting claims are not identical, they are not patentably distinct from each other because although claim 1 of the present application has been amended to include the limitations of claim 2 and the additional limitation of the identification of bidders in the information descriptive. The examiner finds that the support for the inclusion of this limitation is in the specification of both the present and copending application and thus does not serve to render claim 1 of the present application patentably distinct from claims 1 and 2 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claim 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maltzman (2002/0107779) in view of Moshal et al. (2001/0042041), Sloan et al.

(2005/0091140), Sheehan et al. (2001/0049647), Buist et al. (2002/0035534) and Ausubel et al. (2004/00554551), Agarwal et al.(2002/0099646), Hoffman et al. (20020049664) and Official Notice.

As per claim 1;

Maltzman discloses:

A computer implemented method for offering an option to sell and buy items, the method comprising:

offering in a computer system, items to one or more pre-auction bidders at a pre-auction price (paragraph 0018);

receiving into a memory in the computer system, an indication from the one or more pre-auction bidders accepting the offer at the pre-auction price (paragraph 0032, figs. 1, 5a and 5b);

publishing in the computer system, information descriptive of one or more pre-auction sales including the pre-auction price (paragraph 0029, fig.1, server 20 and fig. 4 block 660);

accepting into the memory in the computer system, the offer at the pre-auction price (paragraph 0034, figs. 5B block 330 and 340.

Maltzman does not disclose:

allocating shares of stock comprising an initial public offering.

However, Moshal et al. discloses:

An initial public offering using a Dutch auction (paragraph 0096).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Maltzman and Moshal et al. to offer a system for a plurality of exchanges (Moshal et al., Para. 0006-0009).

Maltzman also does not disclose:

Said information descriptive of the pre-auction sales of shares including the identification of bidders who bought shares at the pre-auction price;

However, Sloan et al. discloses:

Item market data which includes identification of sellers and/or purchasers/bidders on a particular item (Para. 0031).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Maltzman, Moshal et al. and Sloan et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to do so in order to identify buyers who may have purchased items at below market value and may be willing to resell items at an appropriate profit (Sloan et al. Para. 003).

Maltzman also does not disclose:

Auctioning the remaining shares.

However, Sheehan et al. discloses:

Internet based auctions comprising pre-auctions where remaining merchandise is offered in a public auction (paragraph 0009).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Maltzman, Moshal et al., Sloan et al. and Sheehan et al.

One of ordinary skill in the art would be motivated to do so in order to allow preferred trading partners a first opportunity at the offering before the public sale.

As per claim 3;

Maltzman does not disclose:

The method of claim 1 additionally comprising the step of publishing via the computer system, the number of shares offered at the pre-auction price.

However, Sheehan discloses:

A pre-auction over the Internet (paragraph 0009).

Additionally, Buist et al discloses:

Posting on the Internet, auction information including the number of share offered and the auction price (Fig. 15 A, bullets 1 and 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Sheehan et al. and Buist et al.

One of ordinary skill in the art would be motivated to do so in order to find a quick and ready market for goods and services (Sheehan et al. Para. 0009).

As per claim 4:

Maltzman does not disclose:

The method of claim 1 additionally comprising the step of publishing via the computer system, how many shares each pre-auction bidder received.

However, Sheehan et al discloses:

A pre-auction over the Internet (paragraph 0009).

Additionally, Ausubel et al. discloses:

A message sent via computer including the allocation of items among bidders and the payment of the bidders (paragraph 0133).

Finally, Buist et al. discloses:

A method and apparatus for auctioning securities (title).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Sheehan et al., Ausubel et al. and Buist et al.

One of ordinary skill in the art would be motivated to do so in order to provide investors with information they can use to assess the value of the stock and enable them to make sound decisions.

As per claim 5;

Maltzman does not disclose:

The method of claim 1 additionally comprising the step of determining with the processor in the computer system, pre-auction bidders based upon at least one of: investor suitability, investment objectives and prior investment

history.

However, Sheehan et al. Discloses:

Allowing frequent buyers and sellers to pre-register and pre-qualify one another so that goods and services can find a quick and ready market (Para. 0009) and issuing invitations to likely buyers to allow access to first round and pre-auction activities (paragraph 0016).

The examiner asserts that the “investor suitability”, which is not further defined in the specification, is similar in scope to the determination of a “likely buyer”. In addition, the applicants specification (Para. 0034) discloses, pre-qualification as determining investor suitability...or other type of determination that would be indicative of whether a bidder should be able to participate in the IPO. Regardless of the particular terminology used the spirit of the applicant's invention and the reference with regard to this limitation are the same.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Maltzman, Moshal et al., Sloan et al., and Sheehan et al.

One of ordinary skill in the art would be motivated to do so in order to find a quick and ready market for goods and services (Sheehan et al. Para. 0009).

As per claim 6;

Maltzman does not disclose:

The method of claim 1 wherein the pre-auction price is determined by an

issuer of the stock and an underwriter for the stock.

However, Sheehan et al discloses:

A pre-auction over the Internet (paragraph 0009).

Additionally, Agarwal et al. discloses:

Syndication functions that allow underwriters/dealers (issuers) to determine demand for an issue of securities and set a price.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Maltzman, Sheehan et al. and Agarwal et al.

One of ordinary skill in the art would be motivated to do so in order to price the security at a price that is fair to both the seller and the buyer and expedites the sale of the security.

As per claim 7;

Maltzman does not disclose:

The method of claim 1 additionally comprising the step of making available in the computer system, a list of those pre-auction bidders that have previously purchased pre-auction shares comprising an offering underwritten by an investment bank involved in the initial public offering.

However, Sheehan et al. discloses:

Pre-auction trading (paragraph 0009).

Additionally, Hoffman et al. discloses:

A bidder list, compiled in a system, from previous auctions (paragraph 0069, 0072).

Finally, the examiner takes Official Notice that underwriting by an investment bank of shares of stock in an initial public offering is old and well known.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Maltzman, Sheehan et al. and Hoffman et al. together with the underwriting of an investment bank for an IPO.

One of ordinary skill in the art would be motivated to do so in order to provide sufficient notice to interested bidders.

As per claim 8;

Maltzman does not disclose:

The method of claim 7 additionally comprising the step of making available in the computer system, information descriptive of an investment experience related to the previously purchased pre-auction shares comprising the pre-auction price of the previously purchased pre-auction shares.

However, Hoffman et al. discloses:

A bidder list, compiled in a system, with registered bidders comprehensive contact information in their user profiles.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Maltzman and Hoffman et al.

One of ordinary skill in the art would be motivated to do so in order to maintain and access sufficient information about potential bidders to enable sellers to contact the bidders most likely to buy.

As per claim 9;

Maltzman discloses:

A Computer system with processor and storage devices (Para. 0021) where a reserve price is set (Para. 0028).

Maltzman does not disclose:

The method of claim 1 additionally comprising the steps of:

determining with the processor in the computer system, a total amount to be received from accepted pre-auction offers and auction bids;

and conditioning with the processor in the computer system, sale of the shares comprising the initial public offering, upon the total amount equaling or exceeding the reserve price.

However, Moshal et al. discloses:

An auction system where the reserve price has been set and settlement is conditioned upon a sufficient number of buyers bidding at or above the reserve price to sell all items in the auction.

Additionally, the examiner takes Official Notice that it is old and well known in the art to use a computer system or to calculate by hand, the expected amount to be received from pre-auction and auction bids and to use the computer system, or

calculate by hand, whether or not the reserve price has been met and to decide whether or not to issue the IPO as a result e.g. when the Dot com bubble burst, any IPO which expected to raise a particular sum of money but did not may have been subject to cancellation. The examiner points to the Benveniste et al. reference which discloses two methods of IPO sales, the fixed price and the book building method. In the latter method the underwriter solicits orders during road shows that help set the final offer price (Pg. 2, Para. 3) and the expected proceeds are higher (Pg. 2, Para. 2, Pg. 6, Para. 3, Pg. 8, Para's. 3 and 4). In this way the expected proceeds are calculated.

The examiner also points to the Scott reference where due to lack of investor interest and indications of less than expected proceeds the IPO was cancelled (Pg. 4, Para's. 2 and 3)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Maltzman and Moshal et al. and examiner's Official Notice.

One of ordinary skill in the art would be motivated to do so in order to anticipate the prospect of a successful issue by determining the price at which an issue will sell and to automate the process.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM, off alt Fridays beg 6/15/07.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. E. R./
Examiner, Art Unit 3696
03/11/2008

/Daniel S Felten/

Primary Examiner, Art Unit 3696